

REMARKS**Summary of the Office Action**

In the Office Action, claims 1-2, 4-5, 9-10 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,742,924 to Nakayama in view of U.S. Patent No. 6,075,467 to Ninagawa.

Claims 3, 7 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama and Ninagawa, as applied to claims 1, 5 and 10, and further in view of U.S. Patent No. 6,246,958 to Hirono.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama and Ninagawa, as applied to claim 5, and further in view of U.S. Patent No. 6,304,212 to Aoki et al.

Claims 8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claim 17 is allowable.

Summary of the Response to the Office Action

Applicant has amended claims 1 and 9 to differently describe the invention. Accordingly, claims 1-17 remain pending for consideration.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-2, 4-5, 9-10 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama in view of Ninagawa. Claims 3, 7 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama and Ninagawa, as applied to claims 1, 5 and 10, and further in view of Hirono. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama and Ninagawa, as applied to claim 5, and further in view of Aoki et

al. To the extent that these rejections might be applied to the claims as newly-amended, they are respectfully traversed as follows.

Independent claims 1 and 9 now stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama and Ninagawa. Applicant respectfully submits that Nakayama is directed to an apparatus and method for navigating a mobile body, such as an automobile, using a road map stored in an external large-capacity memory unit such as a CD-ROM on a two-dimensional plane. When the road map is displayed on a user's screen, it is displayed in the form of a bird's eye view with a three-dimensional feeling of depth.

The Office Action alleges that Nakayama discloses, at col. 7, lines 25-46, a plurality of memory devices each capable of reading out road map data which is recorded therein, as recited in each of independent claims 1 and 9. Applicant will now discuss the "memory devices" discussed at this portion of Nakayama.

This cited portion of Nakayama describes the above-mentioned CD-ROM 8, which is "an external memory unit which stores the data on the road maps (geographical road maps)." A display 10 displays the road map data in the form of a bird's eye view on which an arrow mark indicates the present position of the vehicle.

This cited portion of Nakayama at col. 7, lines 25-46 goes on to describe a V-RAM (Video Random Access Memory) 12 that "stores temporarily the road map data in the form of the bird's eye view and outputs the road map data to the display in response to an indicate (or display) instruction from the CPU 4." The V-RAM is further described at col. 13, lines 14-16 as serving "to temporarily store the image data to be displayed and which has been coordinate transformed."

The cited portion of Nakayama goes on to describe a RAM (Random Access Memory) that is “used for the temporary storage of the various data” as well as a ROM (Read Only Memory) 14 that “stores a predetermined control program.”

The Office Action concedes at page 2 that Nakayama “does not disclose accessing one of the memory devices, which is selected in accordance with a predetermined condition” with regard to independent claim 1. Similarly, the Office Action concedes at page 4 that Nakayama “does not disclose select one of the first and second memory devices in accordance with a predetermined condition” with regard to independent claim 9.

However, the Office Action then goes on to state that Ninagawa “discloses a road map data reading device for accessing one of the memory devices, which is selected in accordance with a predetermined condition, and reading out the road map data required for the navigation operation therefrom (see columns 5-6, lines 55-36; and columns 7-8, lines 30-9.” The Office Action then concludes that it “would have been obvious ... to modify the teach of Nakayama by combining accessing one of the memory devices, which is selected in accordance with a predetermined condition for satisfying appropriate selection condition that a user request for a route to a destination.” Applicant respectfully traverses this combination rejection for at least the following reasons.

Ninagawa discloses a map data selection supporting device and map data processing system which includes a “map data confirmation” feature disclosed at columns 5-6, lines 55-36; and columns 7-8, lines 30-9. This “map data confirmation feature” involves making a comparison of map data stored in a memory device 5 (such as a read-write hard disk device) with “latest map data” stored on a medium 11 (such as a CD-ROM, DVD, or the like). A controller 3

is able to update the map data in the memory medium 5, using the “latest map data” in the medium if the results of the comparison indicate that updating is required or desired.

However, Applicant respectfully submits that the plurality of memory devices referred to by the Office Action at col. 7, lines 25-46 of the primary reference Nakayama, as discussed above, include only one memory device, CD-ROM 8, that operates along the lines of the plurality of memory devices of the arrangements recited in claims 1 and 9 of the instant application. In other words only CD-ROM 8 is described as a “memory unit which stores the data on the road maps (geographical road maps).”

The remaining “memory devices” described at this cited portion of Nakayama, in particular V-RAM (Video Random Access Memory) 12 and RAM (Random Access Memory) are both used only for temporary storage of data. Moreover, ROM (Read Only Memory) 14 is not utilized for storing map data, but instead “stores a predetermined control program.”

Accordingly, similar to the distinctions provided by Applicant in the response filed on October 14, 2003 with regard to the previously-applied Nimura reference (which was withdrawn by the Examiner in the latest Office Action), these additional memory devices merely describe storing data that is used in conjunction with the map data stored in the CD-ROM memory unit 8.

As discussed at least at pages 3-4 of the instant specification, the navigation system arrangement of the instant invention provides a plurality of memory devices, each of which stores map data. The navigation system can access the a single, optimum memory device depending on a “predetermined condition”, as recited in claim 1, from among the plurality of memory devices to ensure proper navigation operation. See also page 34, line 15- page 35, line 3; and page 40, line 25 to page 41, line 3.

Applicant further emphasizes that claims 1 and 9 each recite that the road map data reading device accesses “one” of the recited memory devices. The plurality of memory devices referred to by the Office Action in Nakayama (i.e., CD-ROM 8, V-RAM 12, RAM and ROM 14) are all used in conjunction with each other. In other words, there is no selection of only one of these memory devices, based on a predetermined condition, as recited in independent claims 1 and 9.

Moreover, while Ninagawa discloses the ability to update map data in a memory device 5 (e.g., hard disk device) based on “latest map data” stored on a medium 11 (e.g., a CD-ROM, DVD, or the like), there is no teaching or suggestion in Ninagawa of providing both of these memory devices together in a navigation system combination, so that only one of them can be selected in accordance with a predetermined condition, as recited in each of independent claims 1 and 9.

Accordingly, Applicant respectfully traverses the combination rejection under 35 U.S.C. § 103(a) at least because Nakayama teaches away from such a combination because Nakayama involves an arrangement in which a plurality of memory devices (i.e., CD-ROM 8, V-RAM 12, RAM and ROM 14) are all used in conjunction with each other, as discussed above. For example, the V-RAM 12 temporarily stores the image data to be displayed after that same image data has been outputted from the CD-ROM 8, where it was previously stored. Even assuming, strictly for the sake of this argument, that Ninagawa teaches what the Office Action asserts, one of ordinary skill in the art would not be motivated to make a combination as suggested by the Office Action because Nakayama teaches away from selecting a single optimum memory device depending on a “predetermined condition” as recited in each of independent claims 1 and 9.

Further along these lines, MPEP § 2143.01 instructs that if “the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” The Office Action’s proposed modification of Nakayama would change its basic principle of operation, which involves a plurality of memory devices working together in conjunction, as discussed above.

Moreover, even assuming, strictly for the sake of this argument, that such references were combinable, Applicant respectfully submits that they would still not teach or suggest all of the recitations of at least independent claims 1 and 9, as discussed above.

For at least the foregoing reasons, Applicant respectfully traverses the combination rejection under 35 U.S.C. § 103(a). Applicant additionally asserts that no motivation exists, outside of the disclosure of the instant application, to make the combination proposed by the Office Action.

Moreover, Applicant respectfully submits that as for the cited portion, columns 5-6, lines 55-36 and columns 7-8, lines 30-9 of Ninagawa, the latest information from a medium 11 (DVD or CD) is actually stored in a maintenance-use memory, and then the map data stored in a memory device 5 (HD) is updated. However, there is no teaching or suggestion in Ninagawa that the map data is directly fetched from a medium 11 (DVD or CD). Moreover, there is no teaching or suggestion in Ninagawa that the controller accesses the medium 11 (DVD or CD) by using the maintenance-use memory. Accordingly, Applicant respectfully submits that Ninagawa does not teach or suggest that only one of a hard disc and a medium such as a DVD, for example, can be selected in accordance with a predetermined condition. The other applied art of record fail to cure these deficiencies of Ninagawa.

Accordingly, in an effort to expedite the prosecution of this application, Applicant has opted to further amend each of independent claims 1 and 9 to recite that the road map data required for the navigation operation is read out "directly from the selected memory device." Moreover, independent claim 1 has been amended to recite that each of the recited plurality of memory devices "stores the same road map data." Applicant respectfully submits that claim 9 has not been newly-amended in this second regard because it already recites that the same road map data is stored in the first and second memory devices.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because the applied art of record, whether taken singly or combined, do not teach or suggest each feature of independent claims 1 and 9, as amended. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicant respectfully asserts that dependent claims 2-7, 10, 12 and 13-16 are allowable at least because of their dependence from claims 1 or 9, and the reasons set forth above.

The Examiner is thanked for the indication that claim 17 is allowed. Moreover, the Examiner is thanked for the indication that claims 8 and 11, while objected to, would be allowable if rewritten in independent form. However, in light of the foregoing comments with regard to independent claims 1 and 9, Applicant respectfully requests that the objections to claims 8 and 11 be withdrawn and these dependent claims also be allowed for at least the same reasons as their respective independent claims 1 and 9.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

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By:



Paul A. Fournier

Reg. No. 41,023

CUSTOMER NO. 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Tel: 202-739-3000

Fax: 202-739-3001